

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed June 4, 2004. In the Office Action, claims 1, 2, 8-12, 16-19, 21-23, and 25 were rejected under 35 U.S.C. § 102, and claims 3-7, 13-15, 20, and 25 were rejected under 35 U.S.C. § 103. Applicant has cancelled claims 1, 10 and 16 without prejudice. Claims 24-26 have been added. Claims 8, 11 and 17 have been placed into independent form to include limitations of claims 1, 10 and 16, respectively. Independent claim 21 has been amended to clarify the limitation of both data and control information being decoding by a Frame Control FEC decoding logic during a first mode of operation and, during a second mode of operation, the control information and data being decoded by different decoders. The dependencies of claims 2-4, 12-13 and 19-20 have been amended accordingly.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Specification

The specification was objected to for containing information that was incorporated by reference from HomePlug 1.0 Specification. Applicants respectfully submit that the information does not constitute essential material and may be added through amendment. However, since the information was not essential to the claimed invention and such information was available to the public prior to the filing of the subject application, Applicant respectfully submits that removal of the incorporation by reference language is warranted.

Applicant respectfully requests that the Examiner withdraw the objection to the specification.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 8-12, 16-19, 21-23, and 25 were rejected under 35 U.S.C. §102(b) as being anticipated by Yonge, III et al. (USP 6,289,000 B1). Applicants respectfully traverse the rejection because a *prima facie* case of anticipation has not been established.

As the Examiner is aware, in order to anticipate a claim under §102(b), Yonge III must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)(Emphasis added). Applicants respectfully traverse the rejection because Yonge III does not teach each and every element set forth in pending independent claim 8, 10, 17 and 21.

For instance, with respect to claim 8, Yonge III does not teach an operation of "processing *both* frame control symbols and data within the blocks by Frame Control Forward

Error Correction (FEC) decoding logic, the processing of both the frame control symbols and data of the payload are conducted by the *same* de-interleaving and decoding operations.” Emphasis added. Instead, as shown in FIG. 2 of Yonge III, the Frame Control FEC decoder (64) is configured to always process the frame control symbols (e.g., OFDM symbols) while the data FEC decoder (68) is configured to always process the data.

Similarly, Yonge III does not teach the following limitations:

Claim 11: encoding *both control information and data within a Frame Control Forward Error Correction (FEC) encoding logic if the HomePlug compliant station is operating in the LORA mode;*

Claim 18: a physical layer in communication with the MAC layer, the physical layer including a *Frame Control Forward Error Correction (FEC) encoding logic to encode and interleave both data and control information associated with the frame during a first mode of operation and a data FEC encoding logic that, during a second mode of operation, encodes and interleaves the data while the Frame Control FEC encoding logic encodes and interleaves only the control information;* and

Claim 21: a Frame Control Forward Error Correction (FEC) decoding logic to *de-interleave and decode both data and control information during a first mode of operation and to de-interleave and decode only the control information during a second mode of operation.*

In light of the foregoing, Applicants respectfully request the Examiner to withdraw the outstanding §102(b) rejection.

Rejection Under 35 U.S.C. § 103

Claims 3-7, 13-15, 20, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yonge III. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *MPEP* §2143, p. 2100-124 (8th Ed., rev. 1, Feb. 2003); See also *In re Fine*, 873 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

More specifically, Yonge III does not describe or suggest any operations where *both* frame control symbols and data are processed by Frame Control FEC decoder (64). In contrast, as shown in FIG. 2 of Yonge III, the Frame Control FEC decoder (64) is configured to only process the frame control symbols (e.g., OFDM symbols) while the data FEC decoder (68) is

configured to only process the data. Hence, the separate processing of the frame control symbols and data by different decoders represents the fact that Yonge III teaches away from the claimed invention, which is a per se demonstration of a lack of prima facie obviousness. *See In re Hedges*, 783 F.2d 1038, 228 U.S.P.Q. 685 (Fed. Cir. 1986).

Applicants respectfully request the Examiner to withdraw the outstanding §103(a) rejection and respectfully invite the Examiner to contact the undersigned attorney if further discussion would facilitate prosecution of the subject application. The undersigned attorney can be reached at the phone number listed below.

Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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